

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the amendments set forth above and the following remarks. Claim 1 has been amended and claim 27 has been added. Support for the amendments and new claim 27 may be at least found in the original specification at page 4, lines 8-9, table 1, page 7, lines 5-12, and from page 7, line 30, to page 8, line 2. Accordingly, claims 1-4, 6-9 and 27 are pending in the present application, of which claim 1 is independent.

Claims 1-4 and 7-8 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,742,680 to Wilson ("Wilson") in view of U.S. Patent No. 6,128,735 to Goldstein et al. ("Goldstein").

Claims 6 and 9 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson in view of Goldstein and further in view of U.S. Patent No. 5,381,481 to Gammie et al. ("Gammie").

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007):

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 1-4 and 7-8

Claims 1-4 and 7-8 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson in view of Goldstein. This rejection is respectfully traversed for at least the following reasons.

The Examiner is requested to withdraw Goldstein as an applicable reference in rejecting pending claims 1-4 and 6-9 as being unpatentable for at least the following reasons.

As stated in the Declaration of Common Ownership filed on September 18, 2008 under 37 CFR 132, U.S. Patent Application No. 09/587,932 and Goldstein were, at the time the invention of U.S. Patent Application No. 09/587,932 was made, owned by Motorola, Inc. Further, Goldstein issued as a patent on October 3, 2000 after the filing date of U.S. Patent Application No. 09/587,932, and Goldstein qualifies as prior art only under subsection (e) of 35 U.S.C. 102. However, subject matter developed by another person, which qualifies as prior art only under subsections (e), (f), (g) of 35 U.S.C. 102 shall not preclude patentability under 35 U.S.C. 103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See 35 U.S.C. 103(c) and MPEP §706.02(I)(2). Thus, Goldstein is disqualified as an applicable reference in the rejection of pending claims 1-4 and 6-9 as being unpatentable. The Declaration is necessary and was not earlier presented in that Goldstein was first applied in the Final Office Action of July 18, 2008.

The **Advisory Action mailed on October 18, 2008** states that Goldstein is an applicable reference because there is previous International Patent Application Publication No. WO 99/27654 to Goldstein et al., which has been published on June 3, 1999. However,

the previous International Patent Application Publication is a **separate reference** from Goldstein, and thus Goldstein itself is not an applicable prior art in this rejection.

Further, amended claim 1 recites a method of providing data, the method comprising, *inter alia*:

...;

storing a second set of encryption data associated with a second data stream wherein the second data stream includes a second number of services that is different from the first number of services and is greater than one, wherein the second number of services are each available for being played at a same time by a destination device, storing the second set of encryption data includes selecting the second number of services from a total number of services desired by an end user to be made available for being played at the destination device at the same time, and the selection is made based on a priority established by the end user among the total number of services in response to a determination that the total number of services exceeds the second number of services . . .

Wilson fails to teach or suggest a selection of a second number of services greater than one from a total number of services desired by an end user to be made available for being played at a destination device at a same time, where the selection is made based on a priority established by the end-user among the total number of services, in response to a determination that the total number of services exceeds the second number of services. Instead, Wilson discloses selecting one of a plurality of simultaneously received encrypted broadcast satellite (DBS) signals for decryption and viewing. Wilson at Abstract, lines 1-4. The Advisory Action mailed on October 8, 2008 asserts at page 3 states that in Wilson, a number of a first data stream carrying a programming for a first channel is different from a number of services of a second data stream carrying a programming for a second channel

because each channel has different programming contents/services. However, while each channel of Wilson may carry different programming contents, Wilson fails to teach or suggest a determination that a total number of programming contents in Wilson exceeds a certain number of services. Further, Wilson fails to teach or suggest a selection of programming contents in Wilson is based on a priority established among a total number of services desired by an end user to be made available, where the priority is used to select a second number of services greater than one for being made available for being played at a same time. Thus, Wilson fails to teach or suggest the above-discussed features of claim 1.

Goldstein fails to overcome the above-discussed deficiencies of Wilson.

Instead, Goldstein discloses that a single encryption engine may be iteratively used for multiple encryption. Goldstein at column 8, lines 22-24. However, Goldstein fails to teach or suggest the above-discussed features of claim 1.

Thus, for at least the foregoing reasons, the proposed combination of Wilson and Goldstein fails to teach or suggest all of the features of claim 1 and its dependent claims. The Office Action has thus failed to establish that claim 1 and its dependent claims are prima facie obvious. The Examiner is therefore respectfully requested to withdraw the rejection of claim 1 and its dependent claims and to allow these claims.

Claims 6 and 9

Claims 6 and 9 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilson in view of Goldstein and further in view of Gammie.

Claims 6 and 9 depend from independent claim 1. Thus, for at least the same reasons set forth earlier with respect to claim 1, Wilson and Goldstein, either alone or in combination, fail to teach or suggest the above-discussed features of claim 1.

Gammie fails to cure the above-discussed deficiency of Wilson and Goldstein. While the Office Action at page 6 relies on Gammie to show features of Data Encryption Standard recited in dependent claims 6 and 9, Gammie fails to teach or suggest the above-discussed features of claim 1.

Thus, for at least the foregoing reasons, the proposed combination of Wilson, Goldstein and Gammie fails to teach or suggest all of the features of claim 1 and its dependent claims 6 and 9. The Office Action has thus failed to establish that claims 6 and 9 are prima facie obvious. The Examiner is therefore respectfully requested to withdraw the rejection of claims 6 and 9 and to allow these claims.

Newly Added Claim

New claim 27 has been added to further define the scope of the invention. In addition to being allowable for their dependencies upon allowable independent claim 1 as discussed above, claim 27 is allowable over prior art for at least the following reasons.

Claim 27 recites “storing encryption algorithm code for use by a processor in response to determining a change from the encryption of the first data stream to the encryption of the second data stream.” Applied references fail to teach or suggest storing an encryption algorithm code in response to determining an encryption change. Thus, applied references fail to teach or suggest the above-discussed features of claim 27.

PATENT

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For at least the above-discussed reasons, claim 27 is submitted to be allowable over the applied references.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 50-3290.

Respectfully submitted,

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